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OFFICE OF PETITIONS

In re Application of
Brown

Application No. 10/749,715

Filed: December 30, 2003

Attorney Docket No. 003C.0006.U2 (US)
For: ELECTRICAL CONNECTOR HAVING
CONNECTOR POSITION ASSURANCE
MEMBER

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: ON PETITION
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This is a decision on the petitions filed May 31, 2005 (certificate of mailing date May 25, 2005) under 37 CFR 1.48(a), and on the petition under 37 CFR 1.47(a), which are being collectively being treated as (1) a petition under 37 CFR 1.48(a) to amend the inventive entity by addition of William R. Lyons (Lyons) and Phillip G. Seminara (Seminara), (2) a constructive petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(2) which requires a statement from the person being added (Seminara), and (3) as authorized by 37 CFR 1.48(a)(3) a petition under 37 CFR 1.47, to accept the declaration filed May 31, 2005 (certificate of mailing date May 25, 2005), which lacks the signature of Seminara required by 37 CFR 1.63.

The petition under 37 CFR 1.48(a) is **dismissed**.

The constructive petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is **dismissed**.

The petition under 37 CFR 1.47 is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT.** The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR 1.48, 1.183, and 1.47."

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from *each person being added* and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the fee set forth in 37 CFR 1.17 (i); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petitions of record lack compliance with items (1) and (2).

With respect to (1) above, each person being added must present *his* statement of lack of deceptive intent, or, if *his* statement cannot be obtained, then upon a showing of (1) extraordinary circumstances, such that (2) justice requires, petitioner may seek waiver under 37 CFR 1.183 of that part of the regulation. See MPEP 201.03(B). Petitioner must show that the inability to obtain the statement from Seminara is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond his control. Under the circumstances of this case, petitioner should proceed as noted in more detail *infra* to make his showing in support of his request for waiver.

With respect to (2) above, the entire showing of record, considered also under 37 CFR 1.47, does not currently warrant acceptance of the declaration under 37 CFR 1.63 and 37 CFR 1.48(a)(3), filed with the instant petition, so as to amend the inventive entity of record under 37 CFR 1.48(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) set forth above.

With respect to (1) above, Rule 47 applicant asserts that an attempt was made to mail a copy of the application papers to Seminara's last known "official" address on April 8, 2005. A reminder letter mailed on May 13, 2005 was not delivered because UPS determined the inventor had moved.

An independent review of the tracking information for the April 8, 2005 mailing (Tracking No. 1Z1823461393986122) reveals that the package was left on the front porch. Since UPS determined that the inventor had moved by May 13, 2005, presumably the April 8, 2005 mailing left on the front porch did not reach Seminara.

The applicable statute (35 U.S.C. 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. See MPEP 409.03(a). The record currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate Seminara so as to obtain his statement under 37 CFR 1.48(a)(2), much less his signature on the declaration, such that the declaration can be accepted under 37 CFR 1.47. Such is required for any renewed petition.

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The following is a list of evidentiary sources that are commonly relied upon to prove inability to locate an inventor: searches of Internet databases; inquiries of local telephone directories; telegrams; and documented inquiries of last known employers. Every listed type of search need not be done. However, a diligent effort to find the inventor must be made.

Documentary evidence that supports a finding that the non-signing inventor could not be found or reached should be made part of any affidavits or declarations that fully describe the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventor. Printed computer records would suffice.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

If Seminara is located, then a copy of the transmittal letter itemizing the 48(a)(2) statement, and complete application papers including declaration, as well as a copy of the proof of service on Seminara will be required.

It is important that the forthcoming reconsideration petitions contain statements of fact as opposed to conclusions. If there is an express oral refusal, a statement from the person to whom that refusal was made should be made of record.

Regarding finances, petitioner has paid the \$200.00 Rule 47 petition fee and the \$130.00 Rule 1.48 processing fee. A \$400.00 1.183 waiver petition fee is required. Pursuant to petitioner's authorization, this fee will be charged to deposit account no. 50-1924.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX until 7/15/05: (703) 872-9306 – ATTN: Office of Petitions
By FAX after 7/15/05: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries pertaining to this decision should be directed to the undersigned at (571) 272-3230.



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Office of Petitions